

REMARKS

The Office Action dated July 20, 2007 has been carefully reviewed and the present amendment prepared in response thereto. Applicant has added new claims 38-41. Claims 1-41 are now pending. Remarks regarding the Examiners rejection of claims 1-20 are provided below.

Rejection of Claims based on 35 U.S.C. 112

The Examiner has rejected claims 1-20 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way to enable one skilled in the art to use the invention. Specifically, the Examiner indicated “[i]t is unclear how the ‘ear’ is actuated through the slot. It is unclear if the ear is pivoted or is pushed up and down or pushed longitudinally. The direction of movement of the ear that the user must exert is ambiguous.”

Applicant respectfully submits that the use of the ear is fully described in the specification to enable one skilled in the art to actuate the ear. Applicant directs the Examiner’s attention to page 8, lines 4-28 and Figures 1 and 3-7 of the originally filed application. Figures 6-7 show the brake actuator as reference numeral 186 and the ear of the brake actuator as reference number 204. Figure 1 shows the ear extending out of the clamp body, such that a user of the clamp may press the ear with his thumb. Further, the clamp body may have ears extending out on both sides of the clamp body such that there may be two separate ears, either or both of which a user may press. Figure 7 illustrates the front face 208 of ear. The rear face of the ear is shown in Figure 6 without a reference numeral but it is clear to one skilled in the art that the rear face of each ear is opposite of the front face 208 of that ear.

Applicant has disclosed two different modes of actuation on page 8 of the specification. As disclosed on lines 4-6 of page 8, one mode of actuation of the brake actuator is accomplished by having the thumb of the hand grasping the handle grip positioned so as to press against the rear face of the ear. This causes the insertion members (shown in Figure 7 by reference numerals 196 and 198) of the brake actuators to be pressed into the recesses, which are shown in Figures 4 and

5 by reference numerals 200 and 202 (see lines 7-8 of page 8). Further, such pressing causes the ear that is being pressed to pivot about the insertion members (see lines 8-11 of page 8).

Consequently, the rib 188 associated with the unpressed ear pivots towards the braking lever forcing the brake lever to a vertical position by pivoting about pivot element 182, thereby releasing the bar (see lines 11-14 of page 8). In other words, by pressing one ear with the user's thumb in one direction, the unpressed ear rotates about an axis to exert a force in the opposite direction so as to press against the brake lever, which forces the brake lever to pivot about 182, releasing the bar. Applicant believes this portion of the original specification clearly describes how the ear is actuated in the first mode.

The first mode, discussed above, requires having the ears of the brake actuator pivoting, while in the second mode the brake actuator is actuated by being pushed longitudinally. The second mode of actuation is described in detail on lines 21-28 on page 8 of the specification. In this mode, actuation is accomplished by a user simultaneously pressing against both front faces 208 of the ears 204 (see lines 21-22 of page 8). Pressing the front faces of the ears 204 moves the insertion members away from the recesses causing the pressed ears 204 to translationally move toward the braking lever (see lines 22-26 of page 8). Consequently, both ribs of the brake actuator contact the brake lever causing the brake lever to pivot about pivot element 182 to a vertical position thereby releasing the bar (see lines 26-28 of page 8).

The Examiner questioned whether the ear was “pivoted or is pushed up and down or pushed longitudinally.” Clearly, lines 8-11 on page 8 answer this question with respect to the how the ear is actuated in the first mode (emphasis added): “[s]uch pressing also causes the pressed ear 204 of the brake actuator 186 to pivot away from the braking lever while the unpressed ear pivots toward the braking lever . . .” Additionally, lines 22-26 on page 8 answer how the ear is actuated in the second mode (emphasis added): “pressing the front faces of the ears 204 moves the insertion members away from the recesses causing the pressed ears 204 to translationally move toward the braking lever 178.” Applicant believes this is a clear description of the operation of the brake actuator.

Applicant submits that both modes of actuation are clearly described in the specification and that

the 112 rejection should be withdrawn. If Applicant has misunderstood the Examiner, clarification of the rejection is respectfully requested.

Rejection of Claims based on 35 U.S.C. 103

Claims 1-12 and 15-20 stand rejected under 35 U.S.C. 103 as obvious over Lee in view of Heinrich. Applicant traverses this rejection.

By way of background, claim 1 teaches a clamp with a clamping jaw, a support element, a clamp body with a handle, a brake lever and a brake actuator. The brake actuator comprises an ear that, when actuated by the user, releases the brake lever. All of the elements of claim 1 are not disclosed by either Lee or Heinrich. However, the Examiner contends that claim 1 is obvious after combining Lee with Heinrich, stating:

"Lee shows an ear 42 that is capable of being actuated from the front and the side of the handle. To fashion this ear such that it extends through the slot or hole in the side of the handle would have been obvious to one skilled in the art at the time the invention was made in view of the disclosure of Heinrich."

Clearly, the Examiner has taken the position that the combination of Lee and Heinrich teach the elements of claim 1. However, the Examiner can only combine Lee with Heinrich if such combination is obvious to one skilled in the art. Applicant strongly contends for several reasons that such combination is not obvious.

In support of this position, Applicant first submits that apparent practical difficulties of making the substitution suggested by the Office Action while maintaining the essential functions of both devices render such a combination unobvious. Indeed, the clamping lever in Heinrich is not a brake release; it is a clamping device. This lever functions to only lock the rod when the rod is in place. Thereafter, the lever forces the jaws to close more, thereby further clamping onto any materials held by the jaws of the clamp. This lever can then be pulled to release the materials held. However, this is a completely different device than a knob (as taught by Lee) that is used solely for releasing the release panel of Lee. Indeed, the release panel of Lee is always engaged in the lock position and only is in the unlock position when the knob is pressed. Clearly, this is

opposite of Heinrich. The release panels in Heinrich are always in the release position until the clamping lever locks the rod in place. With the combination of Lee and Heinrich, will the release panel always be in the lock position or the release position without action by the user? If it is the lock position, then the rod cannot freely slide without action by the user, as required by Heinrich (see Heinrich, column 3, lines 15-20). If the release panel is always in release position (without actuation required by the user), then the handgrip and the catch plate of Lee no longer operate as intended (see Lee, column 3, line 64 – column 4, line 13). Indeed, the handgrip and the catch plate are an integral parts of Lee's invention, "Clamping Device Having an Indirect Driving Mechanism". Additionally, the catch plate would still not allow for the rod to be slid in both directions and Heinrich requires the rod to be "easily slid back and forth" (see Heinrich, column 3, lines 18-19). Clearly, the combination of Lee and Heinrich present problems and would eliminate an essential function of Lee. This is partly due to the fact that the Examiner is trying to substitute a release lever with a clamping lever. It is submitted that the Examiner cannot simply pick and choose pieces from any one reference to make the present invention; instead, the Examiner must consider the entire reference when making the combination.

Secondly, not only do the references not teach or suggest such a combination, the references actually disclose matter "teaching against" such a combination. Lee describes a device that allows the handgrip to step-by-step clamp materials disposed between the jaws. This is done by engaging a pawl and having a release panel that clamps the rod at every step, allowing for very tight clamping of the material. This is the essential invention of Lee – even listed in the title, "Clamping Device Having an Indirect Driving Mechanism." However, Heinrich obviously teaches away from allowing the release panel or catch plate to be engaged while the rod is being slid. Instead, Heinrich teaches the release plate and catch plate must not engage the rod so that the rod is "easily slid back and forth" (see Heinrich, column 3, lines 18-19). Clearly this teaches away from combining Lee and Heinrich.

Third, Applicant submits that even if the references are combined as suggested by the Examiner, the resulting combination would not operate as intended or would be rendered inoperable – rendering such combination nonobvious. In the Office Action, the Examiner stated, "[t]o fashion th[e] ear [of Lee] such that it extends through a slot or hole in the side of the handle would have

been obvious . . .” However, if one moved the knob 42 (and corresponding slot) of Lee to the side of the handle, as suggested by the Examiner, the knob 42 would no longer actuate the release panel. This is because the knob 42 can only actuate the release panel if the knob is orientated in a direction parallel to the direction that the release panel can move – both of which must be along the same direction as the rod 20. When the knob and the release panel are orientated in the same direction as Lee requires, the knob can then exert a force against the face of the release panel, thereby moving the release panel (see Figures 3-4 of Lee). However, if the knob was placed on the side of the handle of Lee as suggested by the Examiner (via a combination of Lee and Heinrich), the knob and the release panel would then be perpendicular to each other, thereby not allowing the knob to exert a force against the face of the release panel. If no force is exerted to the face of the release panel, the release panel will not release the rod, rendering the combination of Lee and Heinrich “inoperable for its intended purpose.” Thus, the combination of Lee and Heinrich is impermissible.

Lastly, it is submitted that the combination of Lee and Heinrich is based on the use of impermissible hindsight and is only obvious if applicant’s disclosure is used as a template for the combination. One factor to consider is whether there is a teaching or suggestion to combine the references as proposed by the Examiner. In the present case there is no such teaching or suggestion in either Lee or Heinrich and it is submitted that one skilled in the art would not have found the combination of references obvious without benefit of the instant disclosure. One skilled in the tool art would clearly not have resorted to the clamping lever of Heinrich to be a brake release for the clamp in Lee.

Applicant submits that Lee and Heinrich are noncombinable and thus, independent claim 1 is nonobvious and allowable. Claims 2-20 depend from claim 1 and thus, are allowable for the same reasons claim 1 is allowable.

Newly Added Claims

Applicant has added new claims 38-41. Neither Lee nor Heinrich render these claims unpatentable.

New claim 38 sets forth a clamp comprising a clamp body having a channel which the support member passes along. The clamp body also has slots, both perpendicular to the support member. Additionally, the clamp in 38 comprises a brake actuator that has two ears and two ribs. The front face of one ear may be pressed and only one rib will actuate the brake lever; alternatively, the rear face of both ears may be pressed substantially simultaneously, causing the ribs to actuate the brake lever. It is submitted that claim 38 is not anticipated by Lee or Heinrich. Further it is submitted that claim 38 is not rendered obvious by Lee and Heinrich either alone or in combination.

New claim 39 discloses a clamp having, in part, a brake lever that is releasably engaged with the support member and a brake actuator that is allowed to pivot about an axis that is substantially parallel to the brake lever. It is submitted that claim 39 is not anticipated by Lee or Heinrich. Further it is submitted that claim 39 is not rendered obvious by Lee and Heinrich either alone or in combination.

New claim 40 discloses a clamp having, in part, a means for tilting the braking lever relative to the support member and having an ear that extends through a slot that is disposed in the clamp body. The ear may be actuated via a force that is in a direction that is substantially parallel to the support member. It is submitted that claim 40 is not anticipated by Lee or Heinrich. Further it is submitted that claim 40 is not rendered obvious by Lee and Heinrich either alone or in combination.

New claim 41 discloses a clamp having, in part, a clamp body that has an upper portion and lower portion, where the lower portion is perpendicular to the support member. The slot faces in a direction that is perpendicular to the lower portion and perpendicular to the support member. The clamp also has an ear that translationally moves from one edge of the slot to an opposite edge of the slot. It is submitted that claim 41 is not anticipated by Lee or Heinrich. Further it is submitted that claim 41 is not rendered obvious by Lee and Heinrich either alone or in combination.

It is submitted that independent claims 38-41 define over the art relied on by the Examiner and

are allowable.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that all claims are now in condition for allowance. Accordingly, allowance of such claims is respectfully requested. If the Examiner has any questions about the present Amendment a telephone interview is requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

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